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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,154	04/22/2004	Takashi Aketa	0171-1087PUS1	5733

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EXAMINER

SCHATZ, CHRISTOPHER

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/829,154

Applicant(s)

AKETA ET AL.

Examiner

Christopher T. Schatz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-5 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 22 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/22/04.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-5 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites the phrase "In connection with a process of." This language is not consistent with the generally accepted language for claiming a method. Examiner recommends applicant use the phrase "A process of preparing an air bag, said process comprising:" Claims 2-5 do not properly further limit claim 1 because claim 1 recites a method and claims 2-5 recite a composition. Applicant should amend the claims to recite "The process of claim 1, wherein the composition comprises."

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 10/372,893 in view of Takuman et al. (EP 1225211). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 2 of the Application No. 10/372,893 share every limitation with claim 1 of the instant application, with the exception of the aluminum hydroxide limitation claimed in claim 1 of the instant applicant. Takuman et al. discloses that aluminum hydroxide powder is a well-known alternative to calcium carbonate powder for an adhesive used to bond silicone rubber (page 4, lines 29-30). Note that claims 2-5 of the instant application are identical to claims 3-6 of the copending application, with the exception of a specific surface treating agent claimed in claim 2 of the instant applicant. Takuman et al., however, discloses that a preferred and advantageous surface treating agent is selected from the group comprising of fatty acids, resin acids organosilazanes and alkoxysilanes (page 3, line 58 – page 4, line 3). Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to use aluminum hydroxide powder in place of calcium carbonate powder and further use a preferred and advantageous surface treating agent selected from the group comprising of fatty acids, resin acids organosilazanes and alkoxysilanes as taught by Takuman et al. in the process of fabricating an air bag as set forth above by Application No. 10/372,893. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6 rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Tackuman et al. (EP 1225211 A2).

The admitted prior art discloses a method of preparing an air bag, said method comprising: furnishing a pair of base fabric pieces impregnated and/or coated with silicone rubber; laying the pieces one on the other with the coated surfaces of the pieces inside; applying an adhesive silicone rubber composition as a sealer to the peripheral portions of the base fabric pieces; bonding or stitching peripheral portions of the pieces together to form a bag; and adding calcium carbonate as a filler to the adhesive (page 1, lines 17-30). The admitted prior art is silent as to the elongation and composition of the adhesive. Takuman et al. discloses an addition reaction adhesive for bonding silicone rubber having an elongation at break of at least 1000% (Table 1), said adhesive comprising: an organopolysiloxane containing at least two alkenyl radicals in a molecule; an organohydrogenpolysiloxane containing at least two silicon atom-bonded hydrogen atoms in a molecule; a platinum group metal catalyst (page 2, lines 34-41); and an organopolysiloxane resin having siloxane units containing alkenyl radicals and siloxane units of the formula: $\text{SiO}_{4/2}$ in a molecule (page 2, line 55). Using a silicone rubber adhesive of the disclosed composition is advantageous because, as disclosed by Takuman et al., doing so

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provides superior adhesion to silicone coated materials (paragraph 0036). Takuman et al. et al. also discloses that aluminum hydroxide powder is a well-known alternative to calcium carbonate powder (see paragraph 4 above). Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to use an adhesive with the composition as taught by Takuman et al. above to increase adhesion between silicone coated layers in the process of fabricating an air bag as set forth above by the admitted prior art.

As to claim 2, Tackuman et al. discloses a method wherein calcium carbonate powder has been surface treated with a surface treating agent selected from the group comprising of fatty acids, resin acids organosilazanes and alkoxysilanes (page 3, line 58 – page 4, line 3). As to claim 3, Takuman et al. discloses a method wherein a silicone rubber adhesive further comprises of a calcium carbonate powder with an average particle size between 0.01 to 50 μm (page 6, line 12). As to claim 5, Tackuman et al. discloses a method wherein a silicone rubber adhesive further comprises of an alkoxysilane or a partial hydrolytic condensate thereof (page 4, line 21). Because Takuman et al. discloses that it is well-known in the art to use aluminum hydroxide powder as an alternative to calcium carbonate, it would have been obvious to one of ordinary skill in the art to replace calcium carbonate with aluminum hydroxide as taught by Takuman above in the method of preparing an air bag as forth by the admitted prior art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Christopher T. Schatz** whose telephone number is **571-272-1456**. The examiner can normally be reached on 8:00-5:30, Monday -Thursday, 8:00-4:30 Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on 571-272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CTS



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